

REMARKS

This Preliminary Amendment accompanies a Request for Continued Examination, and is a response to the Final Office Action of March 7, 2006. Applicants have carefully considered the rejections of the Examiner in the above-identified application. In light of this consideration, Applicants believe that the claims as now amended are allowable. Applicants respectfully request reconsideration of the rejection of the claims now pending in the application.

In the first office action claims 1-37 where provisionally rejected under the doctrine of double patenting. New drawings were indicated as required. Claims 1-13, 16-31, 36 and 37 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,112,203 to Bharat et al. (hereinafter Bharat). Claims 14, 15, and 32-35 were rejected under 35 U.S.C. §103(a) as being unpatentable over Bharat as applied to claims 1-13, 16-31, 36 and 37, and further in view of U.S. Patent No. 6,877,002 to Prince (hereinafter Prince).

In this second office action claims 1-37 have been rejected under 35 U.S.C. §101 as directed to non-statutory subject matter. Claims 1, 16 and 27, have been rejected under 35 U.S.C. §112. Claims 1-6, 10-13, 16-20, 25-31, 36, and 37 are rejected under 35 U.S.C. §103(a) as being unpatentable over Bharat in further view of U.S. Patent No. 5,924,104 to Earl (hereinafter Earl). Claims 7-9, 14, 15, 21-24 and 32-35 are rejected under 35 U.S.C. §103(a) as being unpatentable over Bharat and Earl in further view of Prince.

Claims 1-37 have been rejected under 35 U.S.C. §101 as directed to non-statutory subject matter. That rejection must be respectfully traversed as improper. Documents are very much to be included as "anything under the sun that is made by man". Further a document is clearly an item of manufacture, either as hardcopy (such as a book/magazine etc.) or as data stored on some media (such as digital data stored on a hard-drive, ROM/RAM memory, etc.). Further the claimed invention here directed to a methodology of assembling a document does not fall within one of the judicially created exceptions, it is not directed to an

abstract idea, natural phenomena, or law of nature. The claimed invention here is directed to a methodology of assembling a document, and is thus useful and directed to a practical application. Further, the claimed invention is drawn to a transformation of web page data into a document representation.

The Examiner is directed to: "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" to be found at: http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf; and in particular page 16 thereof where it is stated:

"If the invention as set forth in the written description is statutory, but the claims define subject matter that is not, the deficiency can be corrected by an appropriate amendment of the claims. In such a case, **USPTO personnel should reject the claims drawn to nonstatutory subject matter under 35 U.S.C. § 101, but *identify the features of the invention that would render the claimed subject matter statutory if recited in the claim.***"

This last item as bolded, italicized, and underlined, has not been done. If the Examiner wishes to provide such input, the Applicants are very willing to consider such a suggestion.

A prima facie case for a 35 U.S.C. §101 rejection has not been made out and thus the rejection is improper. The Applicants respectfully request withdrawal of the rejection.

Claims 1, 16 and 27 have been rejected under 35 U.S.C. §112. These claims have been amended and it is believed that the amendments overcome this rejection.

Claims 1-6, 10-13, 16-20, 25-31, 36, and 37, have been rejected under 35 U.S.C. §103(a) as being unpatentable over Bharat in further view of Earl. Bharat teaches that in a computerized method, a set of documents is ranked according to their content and their connectivity by using topic distillation. The documents include links that connect the documents to each other, either directly, or indirectly. A graph is constructed in a memory of a computer system. In the graph, nodes represent the documents, and directed edges represent the links.

Based on the number of links connecting the various nodes, a subset of documents is selected to form a topic. A second subset of the documents is chosen based on the number of directed edges connecting the nodes. Nodes in the second subset are compared with the topic to determine similarity to the topic, and a relevance weight is correspondingly assigned to each node. Nodes in the second subset having a relevance weight less than a predetermined threshold are pruned from the graph. The documents represented by the remaining nodes in the graph are ranked by connectivity based ranking scheme.

It is essential to the understanding of Bharat, that Bharat is directed to a search engine and as such is sorting through pages already identified by a simple word string search (please see column 1, lines 14-54). Bharat is concerned with solving the problem of answering a search engine query, and thus with ranking a set of documents to point to in response to that query. The Applicants however are teaching a methodology, where having identified the location of one document page, which provides how to find and pull together all relevant pages associated with that document into a single coherent document (please see page 5, first paragraph, of the Applicant's specification) representation suitable for subsequent printing and downloaded viewing. As such the Applicants teach "to weed out links which have properties that are not characteristic of typical *intra*-document links" and thus eschew all other documents. Bharat on the other hand, will not link (and thus reject) self referencing pages (intra-document pages) so as not to unduly influence the search outcome (see column 5, lines 17-20) and thus is more interested in *inter*-document links for the sake of ranking links. Bharat does not assemble a single coherent document but a link list of search results responsive to a word query.

Thus Bharat does NOT examine "the collective set of identified candidate document pages to weed out links which have properties that are not characteristic of typical *intra*-document links". Bharat wants those links!

Please also note that Bharat provides no teaching directed to identifying possible “table of content” links. This is one element of the Applicant’s claims which would appear to be being presently ignored at this time.

Earl fails to provide what Bharat lacks. Earl provides link lists just like Bharat but provides different presentation styles for the links depending on whether they are *intra*-document or *inter*-document. Thus Earl also does NOT examine “the collective set of identified candidate document pages to *weed out links* which have properties that are not characteristic of typical intra-document links”.

Therefore Earl in turn fails to provide what Bharat lacks, and thus the combination of Bharat and Earl fails to provide the requirements for a Prima Facie case of obviousness and thus the rejection is improper. The Applicants respectfully request reconsideration of the claims as now amended.

Claims 7-9, 14, 15, 21-24 and 32-35, are rejected under 35 U.S.C. §103(a) as being unpatentable over Bharat and Earl in view of Prince. The combination of Bharat and Earl fail to provide the requirements for a Prima Facie case of obviousness as noted above. Prince teaches a method for querying metadata associated with media, such as multimedia and/or streaming media, on a computer network includes separating the metadata into keywords. The keywords are compared with valid keywords. A score is calculated in accordance with the degree of similarity between the keywords and valid keywords. If the degree of similarity is above a threshold, the metadata is qualified as valid metadata. Valid metadata is available for comparison and correction of other (invalid) metadata. So Prince in turn fails to provide what Bharat and Earl lack, and thus the combination of Bharat, Earl, and Prince also fails to provide the requirements for a Prima Facie case of obviousness, and thus the rejection is improper. The Applicants respectfully request reconsideration of the claims as now amended.

No additional fee is believed to be required for this amendment; however, the undersigned Xerox Corporation attorney authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025.

In the event the Examiner considers personal contact advantageous to the disposition of this case, the Examiner is hereby requested to call the undersigned attorney at (585) 423-6918, Rochester, NY.

Respectfully submitted,

/Christopher D. Wait/

Christopher D. Wait
Attorney for Applicant(s)
Registration No. 43,230
Telephone (585) 423-6918

June 7, 2006
CDW/fsl
Xerox Corporation
Xerox Square 20A
Rochester, New York 14644